

Remarks

Reconsideration of this Application is respectfully requested. Claims 1-8, 14-16, 18, 19 and 32-35 are pending in the application, with claims 1 and 32 being the independent claims. Claims 9-13 and 17 have been canceled. Claims 1, 14-16 and 32 have been amended. The amendment to claim 1 incorporates features from canceled claims 9 and 11, and the amendment to claim 32 incorporates features from canceled claim 11. The amendment to claims 14-16 changes their dependency from claim 9 to claim 1. No new matter is added by way of these amendments, and their entry is respectfully requested.

Based on the above amendments and the following remarks, Applicants respectfully request that the Examiner reconsider and withdraw the outstanding rejections.

Claim Rejections Under 35 U.S.C. § 102(b)

Webb et al. (U.S. 4,385,830)

Claims 1-4, 7-9, 17, 18, 32 and 33 were rejected under 35 U.S.C. 102(b) as being anticipated by Webb et al. (US 4,385,830). Claims 1 and 32 have been amended to incorporate the features recited in claim 11, which was not rejected as being anticipated by Webb et al. Applicants therefore request reconsideration and withdrawal of this rejection under 35 U.S.C. 102(b).

Dittrich et al. (U.S. 3,738,759)

Claims 1, 3, 9, 10, 13 and 17-19 were rejected under 35 U.S.C. 102(b) as being anticipated by Dittrich et al. (U.S. 3,738,759). Claim 1 has been amended to incorporate the features recited in claim 11, which was not rejected as being anticipated by Dittrich et al. Applicants therefore request reconsideration and withdrawal of this rejection under 35 U.S.C. 102(b).

Tateiwa (U.S. 5,444,529)

Claims 1, 4-6, 9 and 14-16 were rejected under 35 U.S.C. 102(b) as being anticipated by Tateiwa (US 5,444,529). Claim 1 has been amended to incorporate the features recited in claim

11, which was not rejected as being anticipated by Tateiwa. Applicants therefore request reconsideration and withdrawal of this rejection under 35 U.S.C. 102(b).

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 11 and 12 were rejected as being unpatentable over Tateiwa. The Office Action states, “it would have been obvious to replace the semiconductor device of Tateiwa with an array chip, an array plate, an array slide... in order to inspect these devices for unwanted particles.” *See*, Office Action at page 8.

Applicants respectfully traverse this rejection. Establishing *prima facie* obviousness requires a showing that each claim element is taught or suggested by the prior art. *See In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Specifically, establishing *prima facie* obviousness requires a showing that some combination of objective teachings in the art and/or knowledge available to one of skill in the art would have lead that individual to arrive at the claimed invention. *See In re Fine*, 5 USPQ2d 1596,1598 (Fed. Cir. 1988). Moreover, establishing *prima facie* obviousness requires not only a showing that such a combination of prior art teachings is possible, but also that the teachings would have 1) motivated the skilled artisan to make the combination to arrive at the claimed invention, and 2) suggested to the skilled artisan a reasonable likelihood of success in making and using the claimed invention. *See In re Dow Chem. Co.*, 837 F.2d 469, 473 (Fed. Cir. 1988). Absent a showing of such motivation and suggestion, *prima facie* obviousness is not established. *See Fine*, 5 USPQ2d at1598.

The present claims recite methods for determination of a dynamic property of a fluid volume, and for analyzing fluid flow, in array chips, array chips or array slides. Tateiwa neither teaches nor suggests such methods and sample devices. The alleged motivation to use such array devices “to inspect these devices for unwanted particles” (*See*, Office Action at page 8) finds no basis at all in the cited reference. Thus, the skilled artisan would have no motivation to replace the device of Tateiwa with the claimed array devices to arrive at the presently claimed methods. Applicants therefore request that the rejection under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider and withdraw all presently outstanding rejections. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

It is not believed that fees for net addition of claims are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional fees are due for net addition of claims are necessary to prevent abandonment of this application, then any fees required are hereby authorized to be charged to Jones Day Deposit Account No. 50-3013.

Respectfully submitted,

Date: January 24, 2005

Laura A. Coruzzi 30,742
Laura A. Coruzzi (Reg. No.)

By: T. Christopher Tsang 40,258
T. Christopher Tsang (Reg. No.)

JONES DAY
222 East 41st Street
New York, New York 10017-6702
(212) 326-3939